

**REMARKS****Summary of the Office Action**

Claims 1-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ueda et al. (U.S. Publication No. 2001/0005442) (hereinafter "Ueda") in view of Ahmad et al. (U.S. Patent No. 6,880,171) (hereinafter "Ahmad") and further in view of Murakami et al. (U.S. 2003/0049029) (hereinafter "Murakami").

**Summary of the Response to the Office Action**

Applicants have amended claims 1, 2, 4, 5, 7 and 8 to differently describe embodiments of the disclosure of the instant application's specification and/or to improve the form of the claims. Accordingly, claims 1-10 remain pending for consideration.

**Rejection under 35 U.S.C. § 103(a) and Statement of Substance of Examiner Interview**

Claims 1-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ueda in view of Ahmad and further in view of Murakami. This rejection is respectfully traversed for at least the following reasons. U.S. Patent and Trademark Office Examiner Omar R. Abdul-Ali is thanked for the courtesies extended to Applicants' undersigned representative during a telephone interview conducted on March 6, 2008. During the interview, Applicants' undersigned representative explained how Murakami et al. (U.S. Patent Publication No. 2003/0049029) ("Murakami") cannot be applied as prior art against the instant application for the following reasons.

Applicants' undersigned representative pointed out in this regard that Murakami cannot be applied as prior art against the instant application because Murakami does not qualify as prior art under 35 U.S.C. § 102(e), or any other section of 35 U.S.C. § 102, against this application. 35 U.S.C. § 102(e) provides that a published U.S. patent application is effective as prior art under 35 U.S.C. § 102(e)(1) as of the application's effective U.S. filing date, which can include an international application filing date, if the following three conditions are met: (1) the international application was filed on or after November 29, 2000, (2) the international application designated the U.S., and (3) the international application PCT publication (by WIPO) was in the English language.

From reviewing PCT WO/2002/067582, which Applicants understand is the WIPO publication of PCT/JP02/01413, it appears that at least item (3) of the foregoing items (1)-(3) is not met because the WIPO publication was not printed in the English language (i.e., it was printed in the Japanese language). A copy of the cover sheet of the PCT WO/02/067582 document is attached hereto which includes an indication near the bottom of the page that the language of the international publication is Japanese. Accordingly, for at least the foregoing reasons, the U.S. Published Murakami Application does not qualify as prior art against the instant application under 35 U.S.C. § 102(e).

However, because the PCT WO/02/067582 document published on August 29, 2002, it may qualify as prior art against the instant application under some other section of 35 U.S.C. § 102, such as 35 U.S.C. § 102(a). In light of this, Applicants are currently filing herewith a Verified Translation of the instant application's Japanese priority document (Japanese Application No. 2002-107159, filed March 5, 2002) in order to remove the published PCT

version of Murakami as prior art against the instant application. The published PCT version of Murakami published on August 29, 2002, and accordingly, it does not predate the filing date of the instant application's priority document.

While the Examiner appeared to understand Applicants' undersigned representative's positions regarding removing the applied Murakami reference as prior art against the instant application, the Examiner requested that Applicants formally file such arguments in writing to ensure that the prosecution file is complete and to give the Examiner an opportunity to consider the issue in more detail. To the extent that any of Applicants' understandings are incorrect in these regards, clarification is respectfully requested to be provided by the Examiner in the next Office communication.

Applicants' undersigned representative also explained during the telephone interview that Applicants would also like to implement some minor changes to particular claims in the next response to be filed. The Examiner responded that, because the instant application is currently under a final rejection, if these claim amendments change the scope of the claims in some regard, then the Examiner will likely issue an Advisory Action stating that the amendments raise new issues. However, the Examiner did confirm that he would at least address in the next Office Communication the above-discussed issue regarding the applicability of Murakami as prior art against the instant application in response to the concurrently-filed remarks.

Applicants' undersigned representative also went on to explain to the Examiner that Applicants intend to also include in the response to be filed the above-discussed Verified English-language translation of the instant application's Japanese Priority Document in order to

pre-date the publication date of Murakami's corresponding PCT publication. The Examiner indicated that he would consider such a Verified Translation once it is formally submitted.

With regard to the newly-implemented claim amendments, Applicants respectfully submit that, even though these changes are being made after a final rejection, such amendments should be entered and considered at this time because they do rise to the level of a "new issue" that would preclude such amendments from being entered and considered at this time. For example, the word "thumbnail" was previously included in the claims before the Amendment filed on August 28, 2007 in this application. **To the extent that the Examiner does not agree with this assertion, the Examiner is respectfully requested provide Applicants with an explanation, in the next Office communication, of why the Examiner believes that any particular amended claim language in the instant Amendment document rises to the level of a new issue that will not be entered and considered at this time.**

### **CONCLUSION**

In view of the foregoing discussion, Applicants respectfully request the entry of the amendments to place the application in clear condition for allowance or, in the alternative, in better form for appeal. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution. A favorable action is awaited.

**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including

any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573.

This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

**DRINKER BIDDLE & REATH LLP**



By:

Paul A. Fournier

Reg. No. 41,023

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**Customer No. 055694**

**DRINKER BIDDLE & REATH LLP**

1500 K Street, N.W., Suite 1100

Washington, DC 20005-1209

Tel.: (202) 842-8800

Fax: (202) 842-8465

**(WO/2002/067582) RECORDING APPARATUS, RECORDING METHOD, AND PROGRAM, AND RECORDING MEDIUM**

Biblio. Data	Description	Claims	National Phase	Notices	Documents
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## Latest bibliographic data on file with the International Bureau

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Applicants: SONY CORPORATION [JP/JP]; 7-35, Kitashinagawa 6-chome Shinagawa-ku, Tokyo 141-0001 (JP) (All Except US).  
MURAKAMI, Masaharu [JP/JP]; C/O SONY CORPORATION 7-35, Kitashinagawa 6-chome Shinagawa-ku, Tokyo 141-0001 (JP) (US Only).  
ARIDOME, Kenichiro [JP/JP]; C/O SONY CORPORATION 7-35, Kitashinagawa 6-chome Shinagawa-ku, Tokyo 141-0001 (JP) (US Only).  
MORIMOTO, Naoki [JP/JP]; C/O SONY CORPORATION 7-35, Kitashinagawa 6-chome Shinagawa-ku, Tokyo 141-0001 (JP) (US Only).

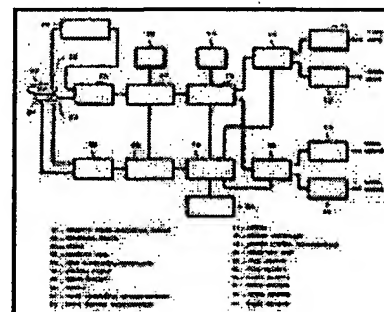
Inventors: MURAKAMI, Masaharu [JP/JP]; C/O SONY CORPORATION 7-35, Kitashinagawa 6-chome Shinagawa-ku, Tokyo 141-0001 (JP).  
ARIDOME, Kenichiro [JP/JP]; C/O SONY CORPORATION 7-35, Kitashinagawa 6-chome Shinagawa-ku, Tokyo 141-0001 (JP).  
MORIMOTO, Naoki [JP/JP]; C/O SONY CORPORATION 7-35, Kitashinagawa 6-chome Shinagawa-ku, Tokyo 141-0001 (JP).

Agent: SUGIURA, Masatomo; 7th Floor, Ikebukuro Park Bldg. 49-7, Minami Ikebukuro 2-chome Toshima-ku, Tokyo 171-0022 (JP).

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Title: RECORDING APPARATUS, RECORDING METHOD, AND PROGRAM, AND RECORDING MEDIUM

Abstract: A recording apparatus comprising a creating means for extracting extraction information related to files recorded on a recording medium and creating an index file containing the extracted extraction information in a predetermined format and real data on the files related to the extracted extraction information, a recording medium identification information storing means for storing identification information for identifying the recording medium in the predetermined format in the index file, and a recording means for recording the index file on the recording medium.



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